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No. 85-975

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

ROSS BICYCLES, INC.,

Petitioner,

—v.—

CYCLES USA, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

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INTRODUCTION

The District Court found that BOSS CRUISER as used by respondent on a particular type of bicycle does not so resemble ROSS as registered and used by

petitioner on its bicycles as to be likely to cause confusion. The Court of Appeals affirmed.

While petitioner uses phrases such as "national importance," "a conflict among the circuits" and "a far departure from the accepted and usual course of proceedings in trademark cases" as grounds for its petition, none of these grounds in fact exists. The District Court applied the proper legal standard in determining that confusion was not likely and the Court of Appeals applied the proper legal standard in affirming that determination. Petitioner's disagreement with that determination is an insufficient basis for granting a writ of certiorari.

I. THE DISTRICT COURT AND THE COURT OF APPEALS APPLIED THE CORRECT LAW FOR DETERMINING TRADEMARK INFRINGEMENT ACTIONS.

The issue in an action for trademark infringement under the Lanham Act is whether there is a likelihood of confusion, mistake or deception. Lanham Act, Section 32(1) [15 U.S.C. §1114(1)].

Each of the circuits has adopted a number of factors to be considered in determining whether a likelihood of confusion exists. In John H. Harland Co. v. Clark Checks, Inc., 711 F.2d 966, 972 (11th Cir. 1983), the Court of Appeals for the Eleventh Circuit set forth the following factual considerations:

> "Among the factors are 'the type of trademark, the similarity of design, the similarity of the product, the identity of retail outlets and purchasers, the similarity of advertising media used, defendant's intent, and actual confusion.'"

Petitioner does not contend that these are the wrong factors to consider in determining likelihood of confusion. Indeed, petitioner recognizes that each of the circuits considers a similar set of factors in determining likelihood of confusion. See, Petition at pp. 9-10 and cases cited therein.

A review of the District Court's opinion shows that it specifically analyzed each of the relevant factors before concluding that there was no likelihood of confusion (Appendix B to Petition, pp. B-12 - B-24). For example, while the District Court found the ROSS mark to be arbitrary when applied to bicycles, it also found the word to be a surname which has a more limited scope of protection than a coined mark such as KODAK.

The District Court also found that the marks at issue were sufficiently dissimilar in overall commercial impression so as to make confusion unlikely. It considered the sound, appearance and meaning of the marks and found that consumers would be able to distinguish between them. It also noted that respondent used its BOSS CRUISER mark in combination with its JAMIS house mark and that the parties used their marks in different positions on their bicycles and in different typestyles.

The District Court was properly influenced by respondent's good faith and by the absence of any evidence of actual confusion. It found that petitioner had offered no probative evidence of actual confusion. In contrast, it accepted

evidence introduced by respondent as to the manner in which the bicycles at issue are purchased. This evidence showed that factors such as price and style were of greater concern to the average customer than a particular brand of bicycle.

The District Court considered these and the other relevant factors before making the ultimate finding that there was no likelihood of confusion. While petitioner disagrees with this ultimate finding, petitioner was unable to convince the Court of Appeals that it was clearly erroneous.

In Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 855 (1982), this Court recognized the significance of the clearly erroneous rule in a trademark case:

> "In reviewing the factual findings of the District Court, the Court of Appeals was bound by the 'clearly erroneous' standard of Rule 52(a), Federal Rules of Civil Procedure. Pullman-Standard v. Swint, ante, p. 273. That Rule recognizes and rests upon the unique opportunity afforded the trial court judge to evaluate the credibility of witnesses and to weigh the evidence. Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U.S. 100, 123 (1969). Because of the deference due the trial judge, unless an appellate court is left with the 'definite and firm conviction that a mistake has been committed,' United States v. United States Gypsum Co., 333 U.S. 364, 395 (1948), it must accept the trial court's findings." (Footnote omitted.)

The Court of Appeals did not depart from this rule in affirming the ultimate finding of the District Court, and there has been no departure from the accepted and usual course of judicial proceedings in trademark infringement actions.

II. THE COURT OF APPEALS OPINION IS NOT OF GREAT NATIONAL IMPORTANCE.

Nothing in the opinion of the Eleventh Circuit presents an issue of national importance. As discussed in Point I, supra, the opinions of the courts below involved factual determinations leading to the ultimate finding of no likelihood of confusion.

Since all trademark cases involve significant factual determinations, it is well-established that they should be decided on a case by case basis with a view to the facts and circumstances peculiar to each case. Scott Paper Company v. Scott's Liquid Gold, Inc., 589 F.2d 1225, 1231 (3d Cir. 1978); Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 530 F.2d 1396, 1399 (CCPA 1976); Continente v.

Continente, 378 F.2d 279, 282 n.3 (9th Cir. 1967); G. Leblanc Corporation v. H. & A. Selmer, Inc., 310 F.2d 449, 457 (7th Cir. 1962). Nothing in the instant case suggests a need to vary from this rule.

III. THE COURT OF APPEALS OPINION DOES NOT CREATE A CONFLICT AMONG THE CIRCUITS ON MATTERS OF TRADEMARK INFRINGEMENT.

Petitioner asks this Court to grant its petition for certiorari because the courts below gave undue consideration in determining likelihood of confusion to the factors of actual confusion and respondent's good faith.

The law in all circuits is similar on the factors to be considered in determining likelihood of confusion. The courts generally consider the presence or absence of actual confusion and the good

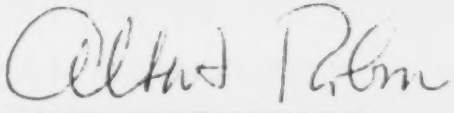
faith of the accused infringer. While some other court might have decided those factors differently than did the District Court and the Court of Appeals in this action, this does not create a conflict among the circuits as to the applicable law.

CONCLUSION

In view of the foregoing, it is respectfully requested that the petition for writ of certiorari be denied.

Dated: New York, New York

December 23, 1985



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